

## REMARKS

### **A. Status of the Claims and Amendments**

Claims 1, 5-8, and 10-18 were examined and rejected in the July 7, 2003 Office Action. The claims have been amended to clarify that they are directed to roofing shingles. Claim 1 also has been amended to remove unnecessary "mixture" language. No claims have been cancelled. Thus, upon entry of these amendments, claims 1, 5-8, and 10-18 will remain pending.

Two paragraphs in the specification have been amended to correct typos, and the BRIEF DESCRIPTION OF DRAWINGS SECTION has been deleted because no drawings were filed.

### **B. Claims 1, 5, 6, and 14 Are Patentable over Bieser**

The Office rejects claims 1, 5, 6, and 14 as being anticipated by U.S. Patent No. 6,214,924 to Bieser et al. (Bieser). The Office uses the same language to reject these claims that it used in the last Office Action. In response to the previous Office Action, Applicant explained in detail why Bieser fails to anticipate these claims. Applicant also submitted a declaration from Dr. Stan Frankoski in support of its arguments.

The Office's only statement in the most recent Office Action that addresses Applicant's declaration and patentability explanation reads:

Applicant's arguments filed April 21, 2003, (including remarks within the Declaration of Stan Frankoski), have been fully considered but they are not persuasive. Bieser et al discloses a polyethylene composition as, for example, at lines 46-62 of col. 7.

Page 6. This statement is not adequate to address or overcome Applicant's evidence. *See* MPEP § 716.01.

The cited portion of Bieser states:

The homogeneous ethylene/ $\alpha$ -olefin interpolymer useful in forming the polyethylene composition of the present invention is typically an interpolymer of ethylene and at least one  $C_3 - C_{20}$   $\alpha$ -olefin and/or  $C_4 - C_{18}$  diolefin, is preferably an interpolymer of ethylene and at least one  $C_3 - C_{20}$   $\alpha$ -olefin, is more preferably

a copolymer of ethylene and a C<sub>4</sub> – C<sub>8</sub> α-olefin, and is most preferably a copolymer of ethylene and 1-octene. **The term interpolymer is used herein to indicate a copolymer, or a terpolymer, or the like. That is, at least one other comonomer is polymerized with ethylene to make the interpolymer.** Preferred comonomers include the C<sub>3</sub> – C<sub>20</sub> α-olefins, especially propylene, isobutylene, 1-butene, 1-hexene, 4-methyl-1-pentene, 1-heptene, 1-octene, 1-nonene, and 1-decene, more preferably 1-butene, 1-hexene, 4-methyl-1-pentene and 1-octene, and more preferably 1-hexene, 4-methyl-1-pentene and 1-octene, and most preferably 1-octene.

Bieser, col. 7 at lines 46-64 (emphasis added). Applicant addressed this portion of Bieser both in the last response (see page 5) and in the Frankoski declaration (see ¶¶ 8-14). Applicant specifically explained that “[a] group of polymers that has been explicitly restricted to copolymers does not disclose or suggest polyethylene.” Frankoski declaration at ¶ 12; Response at page 5. Column 4, lines 16-37 of Bieser further confirms that the homogeneous ethylene/α-olefin interpolymer of his “polyethylene composition” is not polyethylene. See Frankoski declaration at ¶¶ 13-15 (explaining relevant portions of Bieser); Response at pages 5-6.

The Office has not offered an adequate explanation of why Applicant’s declaratory evidence does not overcome the rejection. According to the MPEP, when the Office considers declaration evidence insufficient, it:

must specifically explain why the evidence is insufficient. General statements such as “the declaration lacks technical validity” or “the evidence is not commensurate with the scope of the claims” without an explanation supporting such findings are insufficient.

MPEP § 716.01 at 700-236.

The Office’s reference to a portion of Bieser that Applicant fully addressed in the last response and declaration cannot satisfy this MPEP requirement. Moreover, Bieser does not disclose or suggest a roofing shingle, as the claims now explicitly recite. The rejection should be withdrawn, and claims 1, 5, 6, and 14 should be allowed.

**C. Claims 1 and 5 Are Patentable over Yamamoto**

The Office rejects claims 1 and 5 as being anticipated by U.S. Patent No. 3,981,840 to Yamamoto et al. (Yamamoto). The Office asserts that Yamamoto discloses a “tile” possessing the claimed percentages. Action at page 3. The Office also asserts that the “tile may be manufactured to any desired form and size.” *Id.*

Yamamoto states generally that “[a] variety of molded objects can be made by the process of the invention from thermoplastic resins in combination with an inorganic filler.” Col. 5, lines 20-22. Yamamoto then discloses “floor boards” (col. 5, lines 22-24), “hard artificial stones for making walls and furniture” (col. 5, lines 24-26 and examples 1 and 2), “boards having appropriate rigidity and flexibility” (col. 5, lines 26-29), and “a plate article having a smooth surface and a fine texture” (col. 9, lines 46-47). However, Yamamoto does not disclose or suggest making a composite roofing shingle, which is now explicitly recited as a limitation in claims 1 and 5. Therefore, Yamamoto does not anticipate these claims, or make them obvious.

**D. Claims 10-13 and 15-18 Are Patentable over Bieser**

The Office rejects claims 10-13 and 15-18 as being obvious over Bieser in view of lines 8-11 of page 1 of Applicant’s specification. Action at page 3. The Office asserts:

To have formed the Bieser et al. tile or sheeting of a simulated shake or slate appearance thus forming a tile or sheeting applicable to roofing or siding, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by the disclosure at lines 8-11 on page 1 of the instant specification.

*Id.* at pages 3-4. The cited portion of the background section of Applicant’s specification does not cure Bieser’s deficiencies. Claims 10-13 and 15-18 are therefore patentable for at least the same reasons as the independent claims from which they depend.

Furthermore, the Office has not provided the motivation for making the asserted combination. As the MPEP explains, “[t]he mere fact that references can be combined or

modified does not render the resultant combination obvious **unless the prior art also suggest the desirability of the combination.**” MPEP § 2143.01 at 2100-126. The Office is improperly picking and choosing teachings from the prior art to arrive at what Applicant has claimed, without any supporting motivation for the asserted combination. The rejection should be withdrawn, and claims 10-13 and 15-18 should be allowed.

**E. Claims 6 and 14 Are Patentable over Yamamoto in View of Bieser**

The Office rejects claims 6 and 14 as being obvious over Yamamoto in view of Bieser. Action at page 4. The Office asserts that modifying Yamamoto’s teachings with those of Bieser to “provid[e] a tile of any specific form and size for any desired use or environment, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made[.]” Action at page 4.

The Office is improperly combining references without a motivation. As the MPEP explains, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggest the desirability of the combination.**” MPEP § 2143.01 at 2100-126 (emphasis added). The Office cannot support an obviousness rejection by picking and choosing teachings from the prior art to arrive at what Applicant has claimed, without any supporting motivation for the asserted combination. Moreover, neither Yamamoto nor Bieser discloses or suggests making a roofing shingle, which is now explicitly recited as a limitation in claims 4 and 16. The rejection should be withdrawn, and claims 6 and 14 should be allowed.

**F. Claims 7 and 8 Are Patentable over Yamamoto**

The Office rejects claims 7 and 8 as being obvious over Yamamoto. Action at page 4. The Office asserts that the use of slate or shale as the inorganic fillers of these claims would have

been “an obvious expedient to one of ordinary skill in the art at the time the invention was made.” *Id.*

The Office has not cited any motivation for modifying Yamamoto in this manner. Without such a motivation, the Office is using Applicant’s application as a blueprint for the rejection, a practice that amounts to the impermissible use of hindsight. Furthermore, claims 7 and 8 are patentable for at least the same reasons as claim 1. The rejection should be withdrawn, and claims 7 and 8 should be allowed.

**G. Claims 7 and 8 Are Patentable over Bieser in View of Either Yamamoto or Wells**

The Office rejects claims 7 and 8 as being obvious over Bieser in view of either Yamamoto or Wells (*i.e.*, the ‘126 patent). Action at page 5. The Office asserts that the use of slate or shale as the inorganic fillers of these claims would have been “an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by either Yamamoto or Wells.” *Id.*

The ‘126 patent does not cure Bieser’s deficiencies because the ‘126 patent does not teach or suggest polyethylene. *See* Frankoski declaration at ¶¶ 16-18. Moreover, the Office has not cited any motivation for modifying Yamamoto as asserted. Without such a motivation, the Office is using Applicant’s application as a blueprint for the rejection, a practice that amounts to the impermissible use of hindsight. *See Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (it is insufficient to select from the prior art the separate components of the inventor’s combination, using the blueprint supplied by the inventor). As the MPEP explains, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggest the desirability of**

**the combination.”** MPEP § 2143.01 at 2100-126 (emphasis added). The rejection should be withdrawn, and claims 7 and 8 should be allowed.

**H. Claims 10-13 Are Patentable over Yamamoto in View of Applicant’s Specification**

The Office rejects claims 10-13 as being obvious over Yamamoto in view of lines 8-11 of page 1 of Applicant’s specification. Action at page 5. The Office asserts:

To have formed the Yamamoto tile or sheeting of a simulated shake or slate appearance thus forming a tile or sheeting applicable to roofing or siding, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by the disclosure at lines 8-11 on page 1 of the instant specification.

*Id.*

The Office has not provided the motivation for making the asserted combination. As the MPEP explains, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggest the desirability of the combination.”** MPEP § 2143.01 at 2100-126 (emphasis added). The Office is improperly picking and choosing teachings from the prior art to arrive at what Applicant has claimed, without any supporting motivation for the asserted combination. The rejection should be withdrawn, and claims 10-13 should be allowed.

**I. Claims 15-18 Are Patentable over Yamamoto in View of Bieser and Applicant’s Specification**

The Office rejects claims 15-18 as being obvious over Yamamoto in view of Bieser as applied to claims 6 and 14, and further in view of lines 8-11 of page 1 of Applicant’s specification. Action at page 6. The Office asserts:

To have formed the Yamamoto tile or sheeting of a simulated shake or slate appearance thus forming a tile or sheeting applicable to roofing or siding, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by the disclosure at lines 8-11 on page 1 of the instant specification.

*Id.*

The Office has not provided the motivation for making the asserted combination. As the MPEP explains, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggest the desirability of the combination.**” MPEP § 2143.01 at 2100-126 (emphasis added). The Office is improperly picking and choosing teachings from the prior art to arrive at what Applicant has claimed, without any supporting motivation for the asserted combination. The rejection should be withdrawn, and claims 15-18 should be allowed.

**J. Conclusion**

These remarks fully respond to all outstanding matters for this application. Applicant respectfully requests that the Office withdraw the current rejections rejection and allow pending claims 1, 5-8, and 10-18. Should the examiner desire to discuss this application in more detail by telephone, or if any additional concerns remain, the undersigned attorney may be reached at 512-536-3031 (voice), 512-536-4598 (fax), or by email at [mgarrett@fulbright.com](mailto:mgarrett@fulbright.com).

Respectfully submitted,



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